

Serial No.: 10/734,093

### **REMARKS**

Applicant respectfully requests reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims has not changed.

#### **Request for Telephone Interview**

Applicant kindly requests the Examiner to contact the undersigned at (847) 490-1400 to schedule a telephone interview, to discuss the merits of this Patent Application.

#### **Amendment to the Claims**

Applicant amended Claim 1 to recite "the cutting tool mounts on a lateral face of a rotating body of the stump cutter device." Support for this Amendment can be found, for example, in the drawings; at page 2, last paragraph; and at page 8, first paragraph. No new matter has been added to the claims by this Amendment.

#### **Claim Rejections - 35 U.S.C. §102**

The rejection of Claims 1-16 under 35 U.S.C. §102(b) as anticipated by Stein, U.S. Patent 5,957,176, or Qvart, U.S. Patent 4,932,813, is respectfully traversed.

Neither the Stein Patent nor the Qvart Patent teaches or suggests a cutting tool that mounts on a lateral face of a rotating body of the stump cutter device. Both the Stein and Qvart Patents teach a rotating body with recesses for receiving and centering the cutting elements.

Serial No.: 10/734,093

Reconsideration and withdrawal of this rejection are respectfully traversed.

### **Claim Rejections - 35 U.S.C. §103**

The rejection of Claims 17-20 under 35 U.S.C. §103(a) as being unpatentable over Clemenson, U.S. Patent 4,759,394, is respectfully traversed.

The Office Action deems the additional cutting insert recited in Claim 17 to be a mere duplication of parts in view of the Clemenson Patent. Applicant respectfully disagrees. The Clemenson Patent discloses a front opening slot 16g, into which the single carbide tip 16f is partially inserted. Without Applicant's disclosure of an additional cutting insert, one skilled in the art would have found no suggestion or motivation from the teachings of the Clemenson Patent to add an additional cutting element, as the raised portion forming the front opening slot 16g for each of the teeth 16 would be in the way. As the Clemenson Patent teaches the slot 16g is needed to secure the carbide tip (Col. 2, lines 50-53), there is no suggestion or motivation to remove it to allow room for an additional carbide tip. Neither is there any teaching or suggestion how or why to add an additional carbide tip without removing the raised portion forming the front opening slot 16g.

Reconsideration and withdrawal of this rejection are respectfully traversed.

### **Conclusion**

Applicant intends to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicant has not addressed in this response, Applicant's undersigned attorney requests a telephone interview with the Examiner.



Serial No.: 10/734,093

Applicant sincerely believes that this Patent Application is now in condition for allowance and, thus, respectfully requests early allowance.

Respectfully submitted,

Mark D. Swanson  
Regis. No. 48,498

Pauley Petersen & Erickson  
2800 West Higgins Road, Suite 365  
Hoffman Estates, Illinois 60195  
(847) 490-1400 FAX (847) 490-1403